

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PARK HONG

Appeal No. 1999-1567
Design Application 29/035,428¹

ON BRIEF

Before CALVERT, STAAB, and BARRETT, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

Appellant appeals from the final rejection of the claim in this design patent application which reads:

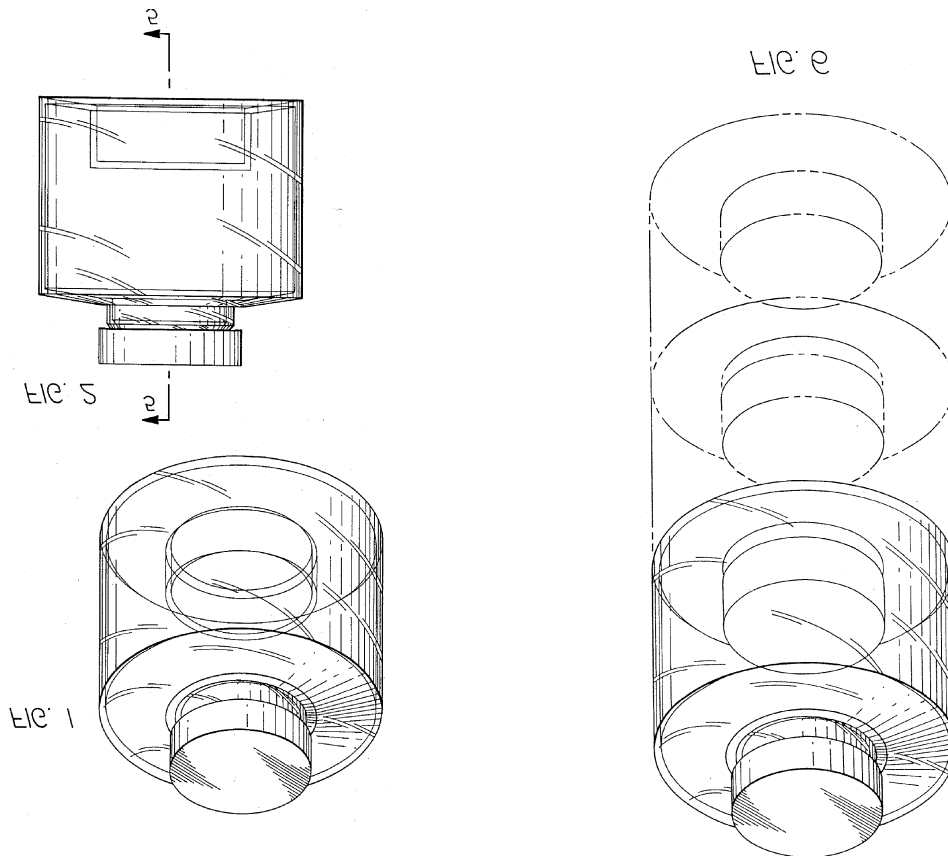
¹ Application for design patent filed February 27, 1995, entitled "SEASONING CONTAINER."

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The ornamental design for a SEASONING CONTAINER as shown and described.

The design is directed to the ornamental design for a transparent, stackable container for seasonings. The characteristic features of the design are summarized in Appellant's brief, pages 2-3.

Figures 1, 2, and 6 are reproduced below.



THE PRIOR ART

The Examiner relies on the following prior art:

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Kasin	Des. 148,862	March 2, 1948
Stolte	2,631,747	March 17, 1953
Bourcart	2,663,450	December 22, 1953

Bourcart teaches a series of stackable containers such as boxes and/or vials or bottles of such shape and dimensions as to fit snugly but removably in a tubular shell 10 having removable end closures 11 and 14. The shell holds four cylindrical boxes 28, 29, 30, and 31, and a vial or bottle 40 at the top. The cylindrical boxes, shown in figure 2, have lids with a projecting portion 49 which is engageable in complementary shaped recesses 50 and 51 in the bottoms of the superimposed boxes 28 to 31 and the vial 40, shown in figure 3. Vial 40 has a flat disc 42 with a neck 43, a cap 44, and a recess 51 dimensioned to receive the projection 49 of one of the cylindrical boxes. The height of the projections and the depth of the recesses are such that the assembled containers will remain in stacked relation and will not slide or tilt readily relative to one another when the containers are removed from the shell 10. "The projections preferably are between about one-sixteenth of an inch and one-eighth of an inch in height and the recesses are of corresponding depth." Col. 3, lines 48-51. Bourcart discloses that the shell and containers may be made of

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transparent or opaque materials (col. 1, line 46 to col. 2, line 8) and states (col. 2, lines 4-6): "By suitable selection of materials, it is possible to produce a very attractive over-all appearance"

Stolte discloses a stackable container for childrens' foodstuffs which when emptied becomes a toy building block. The outside of the container is generally cube shaped. The top wall has a relatively short upstanding circular neck 16 with an airtight closure member 17 of a diameter slightly less than the width of the container. The bottom of the container has a cylindrical recess of such cross section that it slidingly receives, as a loose fit, the upstanding neck 16 and closure member 17 on another container of like construction when the two containers are stacked together (col. 2, lines 26-31).

Kasin discloses a salt shaker with a transparent central section.

THE REJECTION

The claim stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Bourcart, figure 3, in view of Stolte and Kasin. The Examiner concludes that "to modify the reference to Bourcart by providing sides to the bottom recess

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as taught by Stolte and further using a transparent material for the container as taught by the reference to Kasin would have been obvious to a designer of ordinary skill in the art and would meet the appearance of the claimed design" (Final Rejection, p. 2).

We refer to the final rejection (Paper No. 11) and the examiner's answer (Paper No. 17) for a statement of the Examiner's position, and to the appeal brief (Paper No. 15) for Appellant's arguments thereagainst.

OPINION

Legal standards

The proper test for determining obviousness of a claimed design under 35 U.S.C. § 103 is whether the design would have been obvious to a designer of ordinary skill who designs articles of the type involved. In re Nalbandian, 661 F.2d 1214, 1216, 211 USPQ 782, 784 (CCPA 1981). When a § 103 rejection is based upon a combination of references, "there must be a reference, a something in existence, the design characteristics of which are basically the same as the claimed design in order to support a holding of obviousness." In re Rosen, 673 F.2d 388, 391, 213 USPQ 347, 350 (CCPA 1982).

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The designs of other references may properly be relied upon for the modification of this basic design when the references are "so related that the appearance of certain ornamental features in one would suggest the application of those features to the other." In re Glavas, 230 F.2d 447, 450, 109 USPQ 50, 52 (CCPA 1956). As stated in In re Harvey, 12 F.3d 1061, 1063, 29 USPQ2d 1206, 1208 (Fed. Cir. 1993):

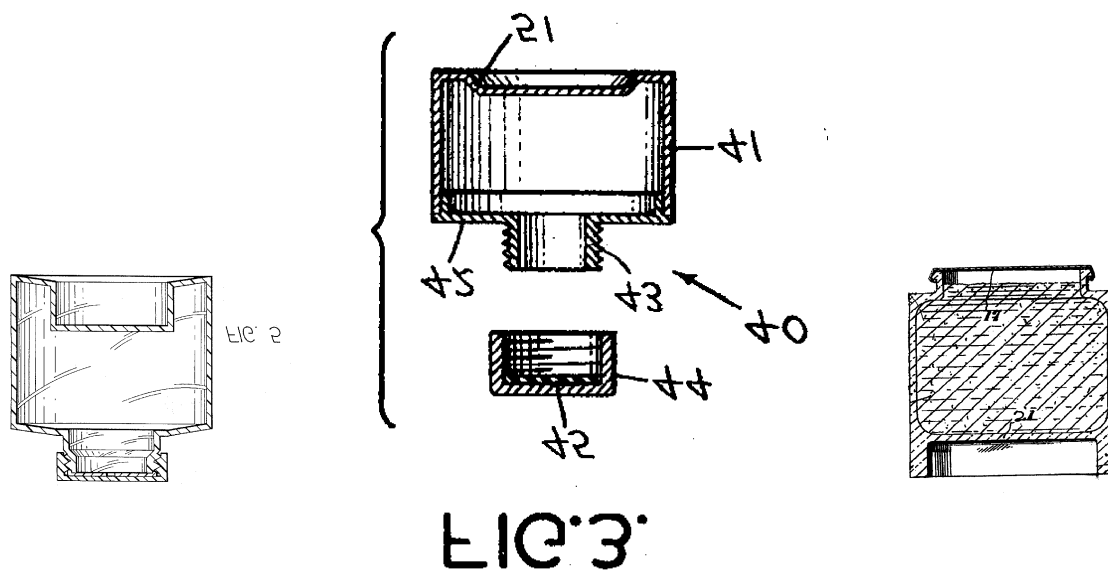
In ornamental design cases, a proper obviousness rejection based on a combination of references requires that the visual ornamental features (design characteristics) of the claimed design appear in the prior art in a manner which suggests such features as used in the claimed design. If, however, the combined teachings suggest only components of a claimed design, but not its overall appearance, an obviousness rejection is inappropriate. [Citations omitted.]

Analysis

Initially, we note that Kasin is not necessary to the rejection because Bourcart expressly discloses that the cylindrical boxes 28-31 and the vial 40 can be of transparent material (col. 1, line 46 to col. 2, line 8) for an ornamental appearance (see col. 2, lines 4-6: "By suitable selection of materials, it is possible to produce a very attractive over-all appearance"). Appellant's arguments that the

claimed design differs from Bourcart because Bourcart shows an opaque container are not persuasive.

Figure 2 of the present design, figure 3 of Bourcart, and a modified version of figure 2 of Stolte to show the container shape are reproduced below for comparison.



Claimed
design

Bourcart

Stolte

We focus on the distinctive feature of the well in the bottom of the container, which is argued by Appellant. There are several other features of the claimed design which differ from Bourcart, e.g., Bourcart shows flat top and bottom walls while those in the claimed design have a slight upward slope,

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the threaded neck is slightly different in Bourcart, and the claimed design has a hole pattern in the closure of the opening which is visible in Appellant's figure 4. Although the Examiner has not addressed these differences, since the differences have not been argued, they will not be addressed.

Bourcart does not disclose a well in the bottom of the vial 40 having a diameter and depth to receive the tubular mouth and cap of a like-shaped container. Instead, the recess 51 is just deep enough (one-sixteenth to one-eighth of an inch, col. 3, lines 48-50) to engage the projection 49 on one of the cylindrical boxes 28-31 so the assembled containers will remain in stacked relation and will not slide relative to one another.

The Examiner's position is (EA3): "It is noted that there is a bottom well in the reference to Bourcart and to merely provide straight walls as taught by Stolte would [have] be[en] obvious. To further enlarge the well as Appellant argues his claimed article shows would [have] be[en] an obvious design expedient. In re Stevens, 81 USPQ 362." See also EA4.

Stolte discloses a container with a short upstanding circular neck 16 and closure member 17 which does not detract

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from the block-shaped appearance. The well in the bottom is shallow and has a large diameter. Thus, although Stolte discloses stacking like-shaped containers, the container in Stolte does not have a bottom well having the appearance of the claimed design. If this were a utility application, we might agree that it would have been obvious for utility reasons to modify the shape of the bottom well of Bourcart so that vials could be stacked on top of each other in view of Stolte or, alternatively, that it would have been obvious to modify the containers in Stolte to use a neck and cap of the shape of Bourcart with a correspondingly shaped bottom well. However, this is a design application and modifications must be done for ornamental reasons. See In re Cho, 813 F.2d 378, 382, 1 USPQ2d 1662, 1664 (Fed. Cir. 1987) ("Although it may have been obvious, from a utility standpoint, to place cylindrical depressions in crown type caps and to include flaps in the depressions, it does not follow that Cho's design was obvious."); Harvey, 12 F.3d at 1063, 29 USPQ2d at 1208 ("In ornamental design cases, a proper obviousness rejection based on a combination of references requires that the visual ornamental features (design characteristics) of the claimed design appear in the prior art in a manner which suggests such

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features as used in the claimed design."). The Examiner has not explained why one of ordinary skill in the design art would have been motivated to modify the size and shape of the bottom well of Bourcart for ornamental reasons. The Examiner's statement that modifying the shape of the well would have been an obvious design expedient is merely a conclusion, without any supporting design or appearance rationale. Therefore, we conclude that the Examiner has failed to establish a prima facie case of obviousness.

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The rejection of the single claim is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
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LEE E. BARRETT)	
Administrative Patent Judge)	

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